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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,705	02/21/2002	Shoji Ohno	500.33860CC3	6283

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EXAMINER

TOPGYAL, GELEK W

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/078,705	OHNO ET AL.	
	Examiner	Art Unit	
	Gelek Topgyal	2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on preliminary amendment filed 15 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/500,261.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>21 February 2002</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 11-12** are non-provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claim 5 of U.S. Patent No. 5,761,371**. Although the conflicting claims are not identical, they are not patentably distinct from each other because

**Regarding claim 11** of this application, claim 5 of U.S. Patent No. 5,761,371 recites a magnetic recording/reproducing apparatus for recording and reproducing a video signal and an information signal on and from a magnetic tape, comprising:

first means for encoding an information signal containing a magnetic tape identifying information signal having an identification number unique to said magnetic

recording/reproducing apparatus and an attribute information signal relevant to a video signal to be recorded on said magnetic tape by superposing said information signal onto said video signal in vertical blanking intervals and recording said encoded information on said magnetic tape;

second means for storing said information signal in storage means upon recording said video signal and said information signal on said magnetic tape;

third means for playing back said magnetic tape and decoding said information signal superposed on said video signal;

fourth means for discriminatively identifying whether an inserted tape is one having had said information signal recorded thereon by said magnetic recording/reproducing apparatus by determining whether said identification number contained in said decoded information signal coincides with the corresponding identification number stored in said storage means;

fifth means responsive to coincidence of said identification numbers for outputting said attribute information signal corresponding to a plurality of programs recorded on said magnetic tape to be played back onto a television screen to be displayed in lines on a program-by-program basis; and

sixth means for selecting a program displayed in a particular one of said lines from those displayed on said television screen in lines, respectively.

The recorder/reproducer, memory, read unit, output unit and the selector of the instant application are met by the first means, second means, third means, fifth means, sixth means, respectively, of claim 5 of U.S. Patent No. 5,761,371. However, claim 5 of

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U.S. Patent No. 5,761,371 fails to teach a searcher which searches a recording position of the selected video on the recording media; and a reproducing controller which controls reproducing so that the selected video signal is reproduced automatically when the search is finished. The sixth means of claim 5 of U.S. Patent No. 6,038,366 discusses the need to select a particular video program from the displayed plurality of programs from the recording medium. It is well known, <sup>and</sup> old, ~~conventional and inherent~~ in the art of the ability during reproduction of a video signal/program recorded on a recording medium (selected through a menu), particularly in the instance of a magnetic tape medium, that the medium has to be searched/fast-forwarded/rewound to a particular point and to automatically play the video signal stored from that location. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the searching and automatic playback in order to decrease the time in searching for the selected program to be played back.

**Regarding claim 12** of this application, claim 5 of U.S. Patent No. 5,761, 371 recites the claimed wherein the identification signal unique to said recording/reproducing apparatus is a manufacture identification number of said recording/reproducing apparatus. It is noted that "identification number unique to said magnetic recording/reproducing apparatus" meets the limitation of the manufacture identification number.

3. **Claims 13 and 14** are non-provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claim 5 of U.S. Patent No. 5,761,371** in view of Matsumoto et al. (US 4,849,696).

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**Regarding claim 13** of this application, claim 5 of U.S. Patent No. 5,761,371 recites a magnetic recording/reproducing apparatus for recording and reproducing a video signal and an information signal on and from a magnetic tape, comprising:

first means for encoding an information signal containing a magnetic tape identifying information signal having an identification number unique to said magnetic recording/reproducing apparatus and an attribute information signal relevant to a video signal to be recorded on said magnetic tape by superposing said information signal onto said video signal in vertical blanking intervals and recording said encoded information on said magnetic tape;

second means for storing said information signal in storage means upon recording said video signal and said information signal on said magnetic tape;

third means for playing back said magnetic tape and decoding said information signal superposed on said video signal;

fourth means for discriminatively identifying whether an inserted tape is one having had said information signal recorded thereon by said magnetic recording/reproducing apparatus by determining whether said identification number contained in said decoded information signal coincides with the corresponding identification number stored in said storage means;

fifth means responsive to coincidence of said identification numbers for outputting said attribute information signal corresponding to a plurality of programs recorded on said magnetic tape to be played back onto a television screen to be displayed in lines on a program-by-program basis; and

sixth means for selecting a program displayed in a particular one of said lines from those displayed on said television screen in lines, respectively.

The recorder/reproducer, memory, read unit, and the output unit of the instant application are met by the first means, second means, third means, and the fifth means, respectively, of claim 5 of U.S. Patent No. 5,761,371. However, claim 5 of U.S. Patent No. 5,761,371 fails to teach 1) that the memory stores a record list including a day of the week and time when the video signal is recorded and 2) a recording controller which controls recording so that a video signal is recorded on the recording media on the same day of the week and time as that included in the record list thus read.

In an analogous reserved recording art, Matsumoto et al. teaches a reserved recording system that stores a reservation including the day of the week and the time period for a desired broadcast program (col. 5, lines 26-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to store the day of the week and time when a video signal is recorded as taught by Matsumoto et al. into the recording system of claim 5 of U.S. Patent No. 5,761,371 in order to facilitate improved management, storage and retrieval of programs stored on a medium.

**Regarding claim 14** of this application, claim 5 of U.S. Patent No. 5,761, 371 recites the claimed wherein the identification signal unique to said recording/reproducing apparatus is a manufacture identification number of said recording/reproducing apparatus. It is noted that "identification number unique to said

magnetic recording/reproducing apparatus" meets the limitation of the manufacture identification number.

4. **Claims 11 and 12** are non-provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claim 1 of U.S. Patent No. 6,038,366**. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Regarding claim 11 of this application, claim 1 of U.S. Patent No. 6,038,366 recites a magnetic recording/reproducing apparatus for recording and reproducing a video signal of a plurality of programs on and from a magnetic tape, comprising:

an encoder which encodes an information signal including a magnetic tape identification information signal having an identification number unique to said magnetic recording/reproducing apparatus and an attribute information signal relevant to a video signal to be recorded on said magnetic tape by superposing said information signal on said video signal in vertical blanking intervals of said video signal, and which records the encoded information signal of said video signal and said information signal on a magnetic tape;

a memory which stores said information signal upon recording said video signal and said information signal on said magnetic tape;

a decoder which decodes said information signal superposed on said video signal upon reproducing thereof from said magnetic tape;

an identifier unit which discriminatively identifies whether an inserted tape is one having had said information signal recorded thereon by said magnetic



recording/reproducing apparatus by determining whether said identification number contained in said information signal as decoded coincides with the corresponding identification number stored in said memory;

an output unit which, responsive to coincidence of said identification numbers, outputs said attribute information signal corresponding to a plurality of programs recorded on said magnetic tape to be played back onto a television screen to be displayed in lines on a program-by-program basis;

a detector which detects a non-recorded portion of said magnetic tape and displays a presence of the non-recorded portion thus detected on a scanning line of said television screen; and

a selector which selects a particular program from said programs corresponding to said attribute information signal displayed on the scanning lines of said television screen and searches the non-recorded portion.

The recorder/reproducer, memory, read unit, output unit and the selector of the instant application are met by the encoder, memory, decoder, output unit and selector, respectively, of claim 1 of U.S. Patent No. 6,038,366. However, claim 1 of U.S. Patent No. 6,038,366 fails to particularly teach a searcher which searches a recording position of the selected video on the recording media; and a reproducing controller which controls reproducing so that the selected video signal is reproduced automatically when the search is finished. The selector of claim 1 of U.S. Patent No. 6,038,366 discusses the need to search the recording medium. It is well known, old, conventional and inherent in the art of the ability during reproduction of a video signal/program recorded

on a recording medium (selected through a menu), particularly in the instance of a magnetic tape medium, that the medium has to be searched/fast-forwarded/rewound to a particular point and to automatically play the video signal stored from that location. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the searching and automatic playback in order to decrease the time in searching for the selected program to be played back.

**Regarding claim 12** of this application, claim 1 of U.S. Patent No. 6,038,366 recites the claimed wherein the identification signal unique to said recording/reproducing apparatus is a manufacture identification number of said recording/reproducing apparatus. It is noted that "identification number unique to said magnetic recording/reproducing apparatus" meets the limitation of the manufacture identification number.

5. **Claims 13 and 14** are non-provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claim 1 of U.S. Patent No. 6,038,366** in view of Matsumoto et al. (US 4,849,696).

**Regarding claim 13** of this application, claim 1 of U.S. Patent No. 6,038,366 recites a magnetic recording/reproducing apparatus for recording and reproducing a video signal of a plurality of programs on and from a magnetic tape, comprising:

an encoder which encodes an information signal including a magnetic tape identification information signal having an identification number unique to said magnetic recording/reproducing apparatus and an attribute information signal relevant to a video signal to be recorded on said magnetic tape by superposing said information signal on

said video signal in vertical blanking intervals of said video signal, and which records the encoded information signal of said video signal and said information signal on a magnetic tape;

a memory which stores said information signal upon recording said video signal and said information signal on said magnetic tape;

a decoder which decodes said information signal superposed on said video signal upon reproducing thereof from said magnetic tape;

an identifier unit which discriminatively identifies whether an inserted tape is one having had said information signal recorded thereon by said magnetic recording/reproducing apparatus by determining whether said identification number contained in said information signal as decoded coincides with the corresponding identification number stored in said memory;

an output unit which, responsive to coincidence of said identification numbers, outputs said attribute information signal corresponding to a plurality of programs recorded on said magnetic tape to be played back onto a television screen to be displayed in lines on a program-by-program basis;

a detector which detects a non-recorded portion of said magnetic tape and displays a presence of the non-recorded portion thus detected on a scanning line of said television screen; and

a selector which selects a particular program from said programs corresponding to said attribute information signal displayed on the scanning lines of said television screen and searches the non-recorded portion.

The recorder/reproducer, memory, read unit, output unit and the selector of the instant application are met by the encoder, memory, decoder, output unit and selector, respectively, of claim 1 of U.S. Patent No. 6,038,366. However, claim 1 of U.S. Patent No. 4,849,696 fails to teach 1) that the memory stores a record list including a day of the week and time when the video signal is recorded and 2) a recording controller which controls recording so that a video signal is recorded on the recording media on the same day of the week and time as that included in the record list thus read.

In an analogous reserved recording art, Matsumoto et al. teaches a reserved recording system that stores a reservation including the day of the week and the time period for a desired broadcast program (col. 5, lines 26-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to store the day of the week and time when a video signal is recorded as taught by Matsumoto et al. into the recording system of claim 1 of U.S. Patent No. 6,038,366 in order to facilitate improved management, storage and retrieval of programs stored on a medium.

**Regarding claim 14** of this application, claim 1 of U.S. Patent No. 6,038,366 recites the claimed wherein the identification signal unique to said recording/reproducing apparatus is a manufacture identification number of said recording/reproducing apparatus. It is noted that "identification number unique to said magnetic recording/reproducing apparatus" meets the limitation of the manufacture identification number.

6. **Claims 11 and 12** are non-provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claim 6 of U.S. Patent No. 6,389,217**. Although the conflicting claims are not identical, they are not patentably distinct from each other because

**Regarding claim 11** of this application, claim 6 of U.S. Patent No. 6,389,217 recites a recording/reproducing apparatus, comprising:

a recorder/reproducer which records/reproduces a video signal and a tape identification signal including an identification signal unique to said recording/reproducing apparatus on/from said tape;

a memory which stores said tape identification signal and a video record list of the video signal recorded on the tape;

a read unit which reads out the video record list from said memory corresponding to said tape identification signal recorded on an inserted tape;

an output unit which outputs the video record list read out from the memory to a display apparatus;

a selector which selects a video signal from the displayed video record list; and

a controller which controls tape driving so that the tape is driven toward a heading point of the selected video signal from a current tape position.

The recorder/reproducer, memory, read unit, output unit, and the selector of the instant application are met by the recorder/reproducer, memory, read unit, output unit, and the selector, respectively, of claim 6 of U.S. Patent No. 6,389,217. However, claim 6 of U.S. Patent No. 6,389,217 fails to particularly teach 1) a searcher which searches a

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recording position of the selected video signal on the recording media and 2) a reproducing controller which controls reproducing so that the selected video signal is reproduced automatically when the search is finished. The controller of claim 6 of U.S. Patent No. 6,038,366 discusses the need to drive the tape to a heading point of the selected video signal. It is well known <sup>and</sup> ~~old, conventional and inherent~~ in the art of the ability during reproduction of a video signal/program recorded on a recording medium (selected through a menu), particularly in the instance of a magnetic tape medium, that the medium has to be searched/fast-forwarded/rewound to a particular point and to automatically play the video signal stored from that location. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the searching and automatic playback in order to decrease the time in searching for the selected program to be played back.

**Regarding claim 12** of this application, claim 6 of U.S. Patent No. 6,389,217 recites the claimed wherein the identification signal unique to said recording/reproducing apparatus is a manufacture identification number of said recording/reproducing apparatus. It is noted that "identification signal unique to said magnetic recording/reproducing apparatus" meets the limitation of the manufacture identification number.

7. **Claims 13 and 14** are non-provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of U.S. Patent No. 6,389,217 in view of Matsumoto et al. (US 4,849,696).

**Regarding claim 13** of this application, claim 6 of U.S. Patent No. 6,389,217

recites a recording/reproducing apparatus, comprising:

a recorder/reproducer which records/reproduces a video signal and a tape identification signal including an identification signal unique to said recording/reproducing apparatus on/from said tape;

a memory which stores said tape identification signal and a video record list of the video signal recorded on the tape;

a read unit which reads out the video record list from said memory corresponding to said tape identification signal recorded on an inserted tape;

an output unit which outputs the video record list read out from the memory to a display apparatus;

a selector which selects a video signal from the displayed video record list; and

a controller which controls tape driving so that the tape is driven toward a heading point of the selected video signal from a current tape position.

The recorder/reproducer, memory, and read unit of the instant application are met by the recorder/reproducer, memory, and read unit, respectively, of claim 6 of U.S. Patent No. 6,389,217. However, claim 6 of U.S. Patent No. 6,389,217 fails to teach 1) that the memory stores a record list including a day of the week and time when the video signal is recorded and 2) a recording controller which controls recording so that a video signal is recorded on the recording media on the same day of the week and time as that included in the record list thus read.

In an analogous reserved recording art, Matsumoto et al. teaches a reserved recording system that stores a reservation including the day of the week and the time period for a desired broadcast program (col. 5, lines 26-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the ability to store the day of the week and time when a video signal is recorded as taught by Matsumoto et al. into the recording system of claim 6 of U.S. Patent No. 6,389,217 in order to facilitate improved management, storage and retrieval of programs stored on a medium.

**Regarding claim 14** of this application, claim 6 of U.S. Patent No. 6,389,217 recites the claimed wherein the identification signal unique to said recording/reproducing apparatus is a manufacture identification number of said recording/reproducing apparatus. It is noted that "identification signal unique to said magnetic recording/reproducing apparatus" meets the limitation of the manufacture identification number.

8. Additionally, it should also be noted that the independent claims 11 and 13 of this instant application have broader limitations, e.g. "recording media", compared to "tape" listed in the parent applications (and corresponding Patents).

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gelek Topgyal whose telephone number is 571-272-8891. The examiner can normally be reached on 8:30am -5:00pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gelek Topgyal  
8/25/2006



THAI TRAN  
PRIMARY EXAMINER